

REMARKS

Claims 1-22 were examined. Claims 1-13, 15, 16 and 20-22 are rejected. Claims 14 and 17-19 are objected to as allowable if rewritten in independent form. Applicants amend claims 1, 8, 10, 15 and 20. Applicants amend claim 8 to correct a typographical error. Applicants amend claim 15 and submit that no new matter is added therein, as claim 15 is supported by the application and claim 17 as originally filed. Applicants amend claims 1 and 20 to include some limitations from claims 5 and 22, and cancel claims 5 and 22. In addition, amendments to claims 1 and 20 are supported at paragraphs 17 and 41 of the application as originally filed. Applicants submit additional claims 23-25 for consideration, and submit that no new matter is added therein as claims 23-25 include limitations from claims 14 and 17 previously presented and/or are supported by the specification as originally filed. Applicants respectfully request reconsideration of the claims 1-13, 15-16, 20-22, and consideration of additional claims 23-25 in view of the following remarks.

I. Claims Rejected Under 35 U.S.C. § 112

The Patent Office rejects claim 15 under 35 U.S.C. § 112 as being indefinite for citing that identifying occurs after loading, while claim 11 states that identifying occurs prior to loading. Applicants amend claim 15 and assert that claim 15 as amended is not indefinite as it requires identifying an additional subset of the data after loading an additional subset of the data after loading. Applicants respectfully request that the Patent Office withdraw the rejection above.

II. Claims Rejected Under 35 U.S.C. § 102

The Patent Office rejects claims 1-2 and 5-7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,119,192 to Kao et al. (Kao). It is axiomatic that to be anticipated every limitation of the claim must be disclosed in a single reference.

Applicants respectfully disagree with the rejection above and submit that claim 1 is patentable over the cited references for at least the reason that the cited references do not disclose wherein the non-volatile memory has a maximum memory size less than a

memory size sufficient to fill all the configuration registers, as required by amended claim 1.

Kao discloses an interface and memory for providing second initialization parameters from a supplemental parameter memory separate and distinct from the system BIOS memory (see column 2 lines 63-67). Specifically, Kao teaches that “any one or more of the initialization registers can be configured in any desired sequence,” (see column 3 lines 13-15) and that the BIOS or supplemental initialization parameters can be used to configure the registers (see column 3 lines 17-20), including a method where a supplemental initialization procedure may be enabled to initialize the controller circuit, or otherwise, if such supplemental initialization procedure is not enabled, initialization of the controller circuit is accomplished using registers from a system BIOS during a normal system boot up routine (see column 3 lines 20-40). Hence, as the Patent Office notes in the final paragraph of page 3 of the current Office Action, the memory has a size equal to a memory size sufficient “to fill some or all of the configuration registers.” Thus, since the memory has a size sufficient to fill all of the configuration registers, it does not have a maximum memory size less than a memory size sufficient to fill all of the configuration registers, as required by amended claim 1.

Hence, Applicants respectfully request the Patent Office withdraw the rejection above.

Any dependent claims not mentioned above are submitted as not being anticipated or obvious for at least the same reasons given above in support of their base claims.

III. Claims Rejected Under 35 U.S.C. § 103

The Patent Office rejects claims 3-4 and 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Kao in view of U.S. Patent Application Serial No. 2004/0143715 to Bonaccio et al. (Bonaccio). To render a claim obvious, every limitation of that claim must be taught or suggested by at least one properly combined reference.

Applicants respectfully disagree with the rejection above and submit that claim 8 is patentable over the cited references for at least the reason that the cited references do not teach or suggest repeating resetting and loading to repeat a multi-stage test data loading process with subsequent test information stored in the non-volatile memory, as required by amended claim 8. As noted by the Patent Office in paragraph 4 of page 13 of the current Office Action (see number 44), the cited references do not teach this limitation of amended claim 8.

Hence, Applicants respectfully request the Patent Office withdraw the rejection above.

The Patent Office rejects claims 11-13 and 15-16 under 35 U.S.C. § 103(a) as being unpatentable over Bonaccio in view of Kao.

Applicants respectfully disagree with the rejection above and submit that independent claim 11 is patentable over the cited references for at least the reason that the cited references do not teach or suggest identifying a subset of the plurality of test data that corresponds to a subset of the plurality of registers having default data values equal to desired data for achieving the desired configuration prior to loading, as required by claim 11.

To address, the above noted limitations, the Patent Office relies upon paragraph 23 and Figure 1 of Bonaccio which shows a chip having a register memory that may be programmed, and describes configuration set 142 including one or more settings for any number of the registers. Moreover, Bonaccio teaches three scenarios for the configuration set: initialize all configuration sets; initialize or replace a single configuration set; or initialize selected parts of a configuration set (see paragraph 29), such as to specify setting values which program specific characteristics (see paragraph 4) to be used during normal operations of the chip (see paragraph 5).

However, the Patent Office has not identified and Applicants are unable to find any teaching or suggesting in Bonaccio of identifying a subset of test data that correspond to a subset of registers having default data values equal to desired data for achieving a desired configuration, as required by claim 11. Here, for instance, test data

is identified as corresponding to registers that reset to desired data. Instead, Bonaccio teaches selecting and using configuration sets to achieve or change a non-desired configuration to a desired configuration, but does not teach identifying test data corresponding to registers having default values equal to desired data for achieving a desired configuration, as required by claim 11. Moreover, there is no teaching in Bonaccio that the registers are reset to a default value that may be equal to desired data for achieving a desired configuration.

Hence, Applicants respectfully request the Patent Office withdraw the rejection above.

The Patent Office rejects claims 20-22 under 35 U.S.C. § 103(a) as being unpatentable over Kao in view of Bonaccio and U.S. Patent No. 5,737,524 to Cohen et al. (Cohen).

Applicants respectfully disagree with the rejection above for at least the reason that the cited references do not teach or suggest wherein the non-volatile memory has a maximum memory size less than a memory size sufficient to fill all the configuration registers, as required by independent claim 20.

Cohen teaches loading configuration registers with information which is stored in a non-volatile storage (see column 2 lines 59-64). However, the Patent Office has not identified and Applicants are unable to find any teaching or suggestion in Cohen of the above noted limitation of claim 20.

Similarly, an argument analogous to the one above with respect to claim 1 and Kao applies here as well. Likewise, Bonaccio teaches initializing all configuration sets (see paragraph 29) and thus does not teach or suggest a memory size as noted above for claim 20. Thus, none of Kao, Bonaccio, Cohen or their combination teaches or suggests the above noted limitation of claim 20.

Hence, Applicants respectfully request the Patent Office withdraw the rejection above.

Any dependent claims not mentioned above are submitted as not being anticipated or obvious for at least the same reasons given in support of their base claims.

IV. Additional Claims 23-25

Applicants submit that additional claims 23-25 are allowable in view of the cited references for at least the reasons that they depend on allowable base claims, and thus are patentable over the cited references for at least the reasons explained above for their base claims.

V. Allowable Subject Matter

Applicants note with appreciation that the Patent Office has indicated that claims 14 and 17-19 are objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form. In addition, Applicants note with appreciation the Patent Office's indication of the reasons for allowance and reminder to amend the title, summary, and abstract, if necessary, after amending claims to include only allowable subject matter identified in the Office Action.

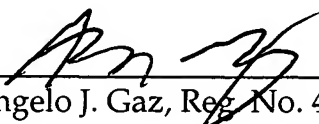
CONCLUSION

In view of the foregoing, it is believed that all claims now are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

 5/9/06

Amber D. Saunders Date